

Applicant : Barry Appelman and Stephen Vaughan
Murphy
Serial No. : 10/747,699
Filed : December 30, 2003
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Attorney's Docket No.: 06975-
415001 / Communications 74-Utility

REMARKS

Claims 1, 2, 5-13, 15, 17, 19-21, 23, 24, 26, 27, 30-38, 40, 42, 44-46, 48, 49 and 51-69 are pending in this application, with claims 1, 26, 51 and 58 being independent. Claims 1, 9, 11, 15, 17, 19-21, 24, 26, 34, 40, 42, 44-46, 49 and 51 have been amended; claims 3, 4, 14, 16, 18, 22, 25, 28, 29, 38, 41, 43, 47 and 50 have been canceled to expedite prosecution; and claims 52-69 have been added. Applicants reserve the right to pursue the subject matter of the canceled claims in this or in a future continuation application. Support for the claim amendments and the new claims may be found in the application at least at pages 33-40. No new matter has been introduced.

Independent claims 1, 26 and 51, and their dependent claims 2-15 and 27-40, have been rejected as being anticipated by Speeny (U.S. Patent No. 6,570,983). Dependent claims 16-25 and 41-50, which depend from claims 1 and 26, have been rejected as being unpatentable over Speeny in view of Gilbert (U.S. Patent Application Publication No. 2004/0001518).

Independent claim 1 recites, among other features, enabling selection of a first sound based upon an identifier, the identifier enabling identification of an entity related to an event and the first sound audibly identifying the entity, and alerting an intended recipient of the event by playing, in response to a received notification of occurrence of the event, at least a portion of the first sound and at least a portion of a second sound that audibly identifies a group to which the entity belongs. Applicants request reconsideration and withdrawal of the rejection of claim 1 and its dependent claims because neither Speeny, Gilbert, nor any proper combination of the two describes or suggests these features.

Speeny describes a method and system for audibly announcing an indication of an identity of a sender of a communication. Speeny describes that in a telephony application, after the first ring of a telephone and before the telephone is raised off-hook by a call recipient, a recorded voice announces the name of a calling party. See col. 2, lines 33-37. As best understood, the Examiner equates the audio announcement of the calling party heard by the call recipient with the recited first sound and equates the first ring of the telephone heard by the call recipient with the recited second sound.

In rejecting previously pending dependent claims 18 and 43, the Examiner apparently acknowledged that Speeny fails to describe or suggest the recited second sound that audibly identifies a group to which the entity identified by the first sound belongs. To remedy this deficiency, the Examiner turned to Gilbert.

Gilbert describes a system and method for emulating a ringback tone at the initiating end of a call while substantially reducing bandwidth usage. The Examiner refers to paragraph 0028 of Gilbert as teaching that a ringback tone can be associated with a geographic location and then, as best understood, uses this teaching to modify Speeny's first ring tone to arrive at the subject matter of claims 18-22 and 43-47 as a matter of "clear design choice." Applicants assert that the combination envisioned by the Examiner is not proper because it is the product of impermissible hindsight and, therefore, request reconsideration and withdrawal of the rejection of claim 1 and its dependent claims over Speeny in view of Gilbert.

Specifically, Gilbert teaches that a ringback tone, not a ring tone, may be associated with a geographic location of the calling party. Notably, a ringback tone is a tone that is played to a *calling party*, not to a *call recipient*. See paragraph 0005 of Gilbert. In contrast, a ring tone is a tone that is played to a *call recipient*. Accordingly, a person of ordinary skill in the art at the time of the invention would not have applied the teachings of Gilbert to Speeny in the manner asserted by the Examiner to somehow change the ring tone of Speeny's telephone heard by the *call recipient* to be associated with the geographic location of the calling party. Rather, at best, a person of ordinary skill in the art, in view of Gilbert's teachings, would have modified the ringback tone heard by the *calling party* of Speeny's system, and NOT Speeny's ring tone heard by the *call recipient*, to be a tone associated with the geographic location of the calling party. Accordingly, applicants submit that the Examiner's proposed combination is not supported by the references but rather is a product of impermissible hindsight.

While Applicants also disagree that the subject matter of previously pending claims 18-22 and 43-47 is a matter of "clear design choice" in view of the combination of Speeny and Gilbert envisioned by the Examiner, applicants do not address this argument at this time given

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that the envisioned Speeny/Gilbert combination itself asserted by the Examiner is improper for the above reasons.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claim 1 and its dependent claims.

Independent claims 26 and 51, while having a different scope than that of claim 1, recite limitations that are similar to those recited by claim 1, but in the context of a computer system and an apparatus, respectively. Accordingly, for at least the reasons described above, applicants request reconsideration and withdrawal of the rejections of claim 26 and its dependent claims, and claim 51.

Applicants submit that all claims are in condition for allowance.

The fees in the amount of \$410 for excess claim fees are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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